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Date: October 12, 2009

Patent 0-06-172 (17660/US/04 CIP)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Bron et al.
Serial no.: 10/588,398
Int. Filed: May 30, 2005
Submitted to USPTO: August 3, 2006
Title: SCORCH PREVENTION IN FLEXIBLE
POLYURETHANE FOAMS
Examiner: Melissa A. Winkler
Art Unit: 1796
Confirmation: 8382

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

Response and Amendment

This response is in reply to the office action mailed on July 20, 2009.

Claims Rejection – 35 USC § 103

Claims 1 - 7, 12 and 13 are rejected as being unpatentable over Barry et al. in view of Kanetani et al (JP-03-100051A, English Abstract). The applicant respectfully traverses that rejection.

The examiner acknowledges that Barry et al do not teach that a stabilizer composition for preventing scorching in polyurethane foams containing flame retardants comprises an epoxy compound. See page 3, line 1 of the Office Action.

Applicant encloses an English machine translation of the specification of Kanetani et al. (An IDS is not required because the USPTO cited the reference and relied exclusively on the English abstract). Kanetani et al. relate to a method of improving mixing of molten phase thermoplastic polyurethanes (TPU) at high temperatures ($\geq 200^{\circ}\text{C}$), so it can be applied to various molding methods (extrusion, injection, etc) (see page 1, lines 29-33). The additives, namely, phosphates (phosphoric acid anhydride or phosphate esters) and epoxy compound (bisphenol A diglycidyl ether included), are used in **combination, not used separately**, to improve and stabilize changes of the TPU's **viscosity** values in its molten state at high temperatures ($\geq 200^{\circ}\text{C}$). As viscosity is the only concern in this patent, melt flow rate (MFR) is the sole parameter being monitored. Kanetani et al. neither teaches nor suggests that an epoxy compound may be used for preventing **scorching** in solid state flame-retarded flexible foams.

Conversely to the examiner's opinion, the Applicant states that Barry et al. and Kanetani et al. are not "concerned with the same field of endeavor, namely stabilized polyurethane composition." See Office Action at page 3, line 3; page 5, line 1 etc. A person having ordinary skill in the art would not relate to Kanetani et al. when looking for solving scorching issues in flame-retarded flexible foams as it is neither the same

material not the same phenomenon, and therefore, stabilization conditions and mechanism would be obviously radically different. Not surprisingly, Barry et al. ignore the work of Kanetani et al. too.

The applicant respectfully submits that it is improper to use hindsight, having read the applicant's disclosure, to pick and choose among isolated prior art references to disparage the claimed invention. *In re Fine*, 837 F.2d 1071; Fed. Cir. 1988. Even where an invention is as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the combination. *ASC Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, Fed. Cir. 1984. Thus the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, Fed. 1992. Finally, it is the invention as a whole that is important. Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. *Gillette Co. v. S.C. Johnson & Son Inc.*, 919 F.2d 720, Fed. Cir. 1990.

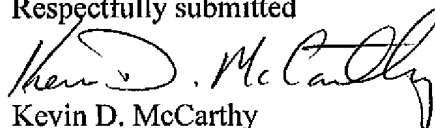
Claims 8-11 and 21-24 are rejected as being unpatentable over Barry et al, in view of Kanetani et al. and further evidenced by Horacek. Applicant respectfully traverses the examiner's rejection.

As discussed above, claims 1 and 14 are novel and non-obvious over the cited prior art. Thus all the claims dependent therefrom should be also acknowledged as novel and non-obvious.

Conclusion

It is believed that in view of the amendments effected and the above explanations, the instant claims define a novel and non obvious invention. Therefore, favorable reconsideration and allowance of the claims are earnestly solicited.

Respectfully submitted



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